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Jacob N. Erlich
Reg. No. 24,338

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Gary R. KLEIN et al.
Application Serial Number: 09/945,111
Filed: August 31, 2001
For: SYSTEM AND METHOD FOR FLEXIBLE PROCESSING OF MANAGEMENT POLICIES FOR MANAGING NETWORK ELEMENTS

Examiner: Marc M. Duncan
Group Art Unit: 2113
Confirm. No.: 2097

AGILENT TECHNOLOGIES, INC.
Intellectual Property Administration
Legal Department, DL 429
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Commissioner for Patents
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Alexandria, VA 22313-1450

AMENDMENT AND RESPONSE UNDER CFR 1.116 TO FINAL OFFICE ACTION AND REQUEST FOR CONTINUED EXAMINATION

Sir:

In response to the Final Office Action dated November 30, 2004, please enter this Amendment and Response together with the Request for Continued Examination. A petition for an extension of time under CFR 1.136(a), including the appropriate fees, are provided herewith. It is believed that the Amendment and Response places this application in condition for allowance.

Amendments to the Claims are reflected in the listing of claims that begins on page 2 of this paper.

Remarks/Arguments begin on page 8 of this paper.

If the references when combined would render the prior art invention being modified unsatisfactory for its intended purpose, there is no motivation to combine the references. *McGinley v. Franklin Sports, Inc.*, 262 F.3d at 1354; *In re Gordon*, 733 F.2d at 902. Therefore, there is no motivation to integrate the teachings of Buzsaki and Winokur et al..

If the only teaching of Winokur et al. relied on by the examiner is the fact that Winokur et al. teach that the managed system is a network, that is tantamount to the assertion that one of ordinary skill in the relevant art would have been able to arrive at the applicants' invention because he/she had the necessary skills to arrive at such a conclusion. This is not an appropriate standard for obviousness. The fact that elements are known per se does not provide a motivation to combine. See *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986). That which is within the capabilities of one skilled in the art is not synonymous with obviousness. *Ex parte Gerlach*, 212 USPQ 471 (Bd.App. 1980).

Thus, assuming *arguendo* that Buzsaki and Winokur et al. either separately or in combination teach or suggest all the limitations of the amended independent claims, there is no motivation to combine.

Therefore, applicants assert that a *prima facie* case of obviousness has not been established and that claims 1, 3-5, 8-16, and 19-23 are patentable over Buzsaki in view of Winokur et al.

In conclusion, in view of the above remarks, Applicants respectfully assert that the claims in this application are now in condition for allowance and respectfully request the Examiner to enter the amendments presented herein and find claims 1, 3-5, 8-16, and 19-25 allowable over the prior art and pass this case to issue.

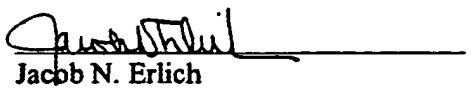
Since the number of independent claims has increased by two, a fee of $400.00 should be charged to Deposit Account No. 50-1078. If additional fees are required, they should be charged to Deposit Account No. 50-1078.

In accordance with Section 714.01 of the MPEP, the following information is presented in the event that a call may be deemed desirable by the Examiner:

JACOB N. ERLICH (617) 854-4000

Respectfully submitted,
Gary R. Klein et al., Applicants

Dated: May 27, 2005

By: 
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